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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,112	11/13/2003	Mitsumasa Tsuchiya	019519-409	7708

21839 7590 11/14/2005

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EXAMINER

LE, HOA VAN

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/706,112

Applicant(s)

TSUCHIYA ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-21 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24 (broadest), 17-21, 23 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/901,676.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

This is in response to Papers filed on 02 September 2005.

I. The record shows that applicants elects compound Y-1 species. The elected species has been considered and searched. The consideration and search are extended to the applied species being read within the general formula (I-B). Others has not been considered or searched until all of the elected and applied species are overcome.

II. Claims 24 (broadest), 17-21, 23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al (5,532,116).

Suzuki et al disclose and teach an alkaline aqueous developing composition comprising up to 4 wt% of a polyoxyethylene (2-50 units) naphtyl ether being read on and/or within the general formula (I-B) in the claims. Please see the whole disclosure of each of the applied reference, especially at col.9:39-42, 10:65-67, 11:7-10, 17:62-64 and 18:6-8).

Suzuki et al do not specify "to a divalent metal" as that in claim 20. Tanka et al disclose and teach the use of a chelating agent. It is reasonable that the known chelating agent in the art is able to chelate a divalent metal as claimed. The

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language "...to a divalent metal" is a property of a material. It is allowed to request and require applicants to show or provide a convincing evidence to the contrary for a patentability of the claim in accordance with the authority as stated in *In re Schreiber*, 44 USPQ2d 1429.

Suzuki et al do not specify "an electrical conductance..." as that in claim 21. Tanka et al disclose and teach the use of about 90 g/l or their maximum amount to provide a pH solution of up to 14 of the strong charge sodium carbonate and sodium bicarbonate in the aqueous composition. It is reasonable that the aqueous has "an electrical conductance..." as claimed. The language "electrical conductance..." is a property of a material. It is allowed to request and require applicants to show or provide a convincing evidence to the contrary for a patentability of the claim.

Since Suzuki et al are reasonable disclose and teach the claimed embodiments, claims 24(broadest), 17- 21 and 23 are found to be anticipated by Suzuki et al.

IV. Applicant's arguments filed 01 August 2005 have been fully considered but they are not persuasive.

Applicants urge that Suzuki et al do not disclose or teach a compound of the general formula (I-B) and its using amount in the claims. Please see Suzuki et al teachings at col.9:39-42, 10:65-67, 11:7-10.

V. Toyama et al (4,880,724) at col.4:61-63 is cited to show the teachings and suggestions of the use of “EDTA, NTA, etc.” as chelating agent in the art.

VI. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available


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through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
09 November 2005

HOA VAN LE  
PRIMARY EXAMINER

A handwritten signature in black ink that reads "Hoa Van Le". The signature is written in a cursive style with a large initial "H" and a stylized "V" and "L".